

R E M A R K S

I. Introduction

In response to the pending Office Action, Applicants have amended the claims so as to address the Examiner's rejection of the same under 35 U.S.C. § 112, first and second paragraph. For the reasons set forth below, it is respectfully submitted that the rejection of the claims under 35 U.S.C. § 112 has been overcome.

II. The Rejection Of The Claims Under 35 U.S.C. § 112, First Paragraph

Claims 1-14 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the specification in a manner so as to convey to one of reasonable skill in the art that the Applicants' had possession of the invention at the time of filing the application.

In particular, the language "based on the user's necessity" and "calculating an user's necessity" was objected to as the term "user's necessity" is not described in the specification. In response to this rejection, Applicants have deleted the term "user's necessity" from the claims, and substituted therefore the term "degree of importance". As noted by the Examiner, the term "user's necessity" was intended to indicate a value representing how strongly the user wants a given image when retrieving an image from the database. Applicants submit that the new language (i.e., degree of importance) makes this point clear. Further, the term "degree of importance" is expressly referenced in the specification on, for example, page 6, lines 19-27. Thus, the specification clearly provides support for the term.

Accordingly, it is respectfully submitted that the foregoing amendments to the claims

overcomes the pending rejection of the claims under 35 U.S.C. § 112, first paragraph.

III. The Rejection Of The Claims Under 35 U.S.C. § 112, Second Paragraph

Claims 1-14 were rejected under 35 U.S.C. § 112, second paragraph, as containing subject matter not described in the specification in a manner so as to convey to one of reasonable skill in the art that the Applicants' had possession of the invention at the time of filing the application.

Similar to the rejection set forth under 35 U.S.C. § 112, first paragraph, the instant rejection was also based on the use of the term “user’s necessity”. As noted above, this term has been deleted and replaced with the term “degree of importance” which is clearly supported by the specification. As such, it is respectfully submitted that the instant rejection has also be overcome the foregoing amendments to the claims.

In addition, claims 1-14 were rejected for omitting essential elements from the claim. In particular, it is asserted that the “operator interface” for allowing the operator to assign priorities to a keyword needs to be recited by the claim. Applicants respectfully traverse this rejection. With regard to claim 1, it is noted that claim 1 is a method claim. It is improper for the USPTO to require that the Applicants limit the *method* claim by adding structural language to define the operator interface. Indeed, as claim 1 currently reads, it is readily understandable by one of skill in the art. Specifically, claim 1 recites “assigning a priority to a keyword, said keyword operative as a tag”. Clearly there are numerous techniques for performing the foregoing function step. Those of skill in the art could readily practice the process. As such, nothing more is required. As is well known, “claims need only ‘reasonable apprise those skilled in the art’ as to their scope and

be 'as precise as the subject matter permits'". *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367 (Fed. Cir. 1986).

Turning to claim 4, this claim actually recites a "menu entry section" for assigning priorities to keywords. Thus, claim 4, which is the device claim, recites a structural limitation directed at assigning priorities to keywords. As such, it is respectfully submitted that claim 4 does not omit any essential element as is suggested in the pending rejection.

For all of the foregoing reasons, it is respectfully requested that all pending claims fully comply with the requirements of 35 U.S.C. § 112, second paragraph.

IV. Request For Notice Of Allowance

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that Applicant has inadvertently overlooked the need for a petition for extension of time. The Commissioner is hereby authorized to charge

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any additional fees associated with this communication or credit any overpayment to Deposit

Account No. 50-0417.

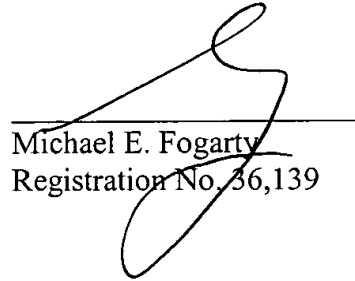
Respectfully submitted,

MCDERMOTT, WILL & EMERY

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1/22/09

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